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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY PAUL DRUMMOND and MARK D. SMITH

Appeal 2007-4102
Application 09/966,909
Technology Center 1700

Decided: March 31, 2008

Before HUBERT C. LORIN, DAVID B. WALKER, and JOSEPH A. FISCHETTI,
Administrative Patent Judges.

LORIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Drummond, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.¹

¹ Our decision will make reference to Appellants' Appeal Brief ("App. Br." filed Mar. 2, 2007), the Examiner's Answer ("Answer," mailed Apr. 30, 2007) and the

THE INVENTION

The Appellants' claimed invention relates to an automated banking machine method and system involving a portable device in a wireless environment (Specification 1:5-7). Claims 1, 6, and 7, reproduced below, are representative of the subject matter on appeal.

1. A method comprising:

- a) receiving with an automated banking machine at least one first wireless communication signal from a portable wireless device;
- b) sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network;
- c) receiving through operation of the banking machine at least one second network communication signal from the at least one server; and
- d) sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal.

6. Computer readable media bearing instructions which are operative in at least one computer to cause the automated banking machine to carry out the method comprising:

- a) receiving with an automated banking

Reply Brief ("Reply Br.," filed Jun. 21, 2007).

machine at least one first wireless communication signal from a portable wireless device;

b) sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network;

c) receiving through operation of the banking machine at least one second network communication signal from the at least one server; and

d) sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal.

7. Apparatus comprising:

an automated banking machine including a computer;

at least one transaction function device in the machine and in operative connection with the computer; and

an external network interface in operative connection with the computer, wherein the external network interface enable the machine to communicate in a wide area network; and

a wireless access hub in operative connection with the computer, wherein the wireless hub enables the machine to communicate with at least one portable wireless device, wherein the machine is operative to enable the at least one portable wireless device to communicate in the wide area network.

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THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Jones	US 5,905,810	May 18, 1999
Joao	US 2001/0051920 A1	Dec. 13, 2001
Bansal	US 6,439,456 B1	Aug. 27, 2002
Laybourn	US 6,480,710 B1	Nov. 12, 2002
Stewart	US 6,732,176 B1	May 4, 2004

The following rejections are before us for review:

1. Claim 17 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.
2. Claims 1, 4, 6, and 18 are rejected under 35 U.S.C. § 102(e) as being anticipated by Joao.
3. Claims 1, 4, 6, and 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Joao.
4. Claims 7, 11, and 16-17 are rejected under 35 U.S.C. § 103(a) as unpatentable over Joao and Stewart.
5. Claims 5 and 13-15 are rejected under 35 U.S.C. § 103(a) as unpatentable over Joao and Bansal.
6. Claims 2 and 19-20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Joao and Laybourn.
7. Claims 9-10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Joao, Stewart, and Laybourn.

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8. Claims 3, 8, and 12 are rejected under 35 U.S.C. § 103(a) as unpatentable over Joao and Jones.

Claims 1, 6, and 18 were also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 15, and 21 of US 6,796,490. (Answer 8-9). However, a terminal disclaimer was filed (Jun. 21, 2007) and approved by the Office (Jul. 20, 2007). Accordingly, this rejection is moot. (See also Reply Br. 4 and the Examiner's response thereto of Jul. 25, 2007.)

ISSUES

The first issue before us is whether the Appellants have shown that the Examiner erred in rejecting claim 17 as being indefinite. This issue turns on whether the phrase "relatively short" as used in the claim is vague and indefinite.

The second issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1, 4, 6, and 18 as being anticipated by Joao.

The third issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1, 4, 6, and 18 as unpatentable over Joao. This issue turns on whether providing an electronic cash device sending a signal to the server *corresponding* to a first wireless communication signal it receives and the electronic cash device sending a second signal to the communication device *corresponding* to a signal received from the server (claims 1, 4, and 6) and an automated banking machine determining if a portable device is permitted access to a public WAN and, in response thereto, providing the portable device with access

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to the public WAN through a wireless connection with the automated banking machine (claim 18) would have been obvious over Joao to one of ordinary skill in the art.

The fourth issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 7, 11, and 16-17 as unpatentable over Joao and Stewart.

The fifth issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 5 and 13-15 as unpatentable over Joao and Bansal.

The sixth issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 2 and 19-20 as unpatentable over Joao and Laybourn.

The seventh issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 9-10 as unpatentable over Joao, Stewart, and Laybourn.

The eighth issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 3, 8, and 12 as unpatentable over Joao and Jones.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed.

Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

The scope and content of the prior art

1. Joao is directed to a system for collecting account transaction information.
2. It is an object of Joao's invention to allow an individual to obtain access to account transaction information on the server via the communications device. See para. [0073]
3. Another object of Joao's invention is to provide a method for providing a wireless device owner, for example, to increase or decrease account credit limits. See para. [0084].
4. Joao paras. [0250], [0252], [0254], [0255], and [0259] describe a system comprising an electronic cash device, a central processing computer, and an account owner communication device (which can be wireless). See elements 302, 303, and 304, in Fig. 10, respectively.
5. Para. [0250] (referring to Fig. 10) of Joao reads as follows:

The electronic cash device 302 may also comprise, and/or have associated therewith, a keypad for the manual entry of electronic cash transaction information and/or data, such as the amount of the electronic cash transaction information and/or data, such as the amount of the electronic cash transaction, account number, etc. The electronic cash device 302 may also be an integral component of a cashier or operator work station and/or other transaction terminals and/or devices, including those which may provide for the automatic entry of electronic cash transaction information and/or data.
6. Para [0252] of Joao reads as follows:

In the preferred embodiment, the electronic cash device 302 is linked and/or connected to the central processing computer 303 via a telecommunications system, link and/or medium (hereinafter referred to as "communications system") such as, for example, a telephone network or line. As noted above, the electronic cash device 302 may or may not be linked to the central processing computer 303 via a central computer. It is important to note that the communication system which is utilized may be any communication system and may include telecommunication systems, satellite communication systems, radio communication systems, digital communication systems, digital satellite communication systems, personal communications services communication systems, cable television communication systems, broadband communication systems, as well as any other appropriate communication system. The electronic cash device 302 transmits signals and/or data to the central processing computer 303 as well as received signals and/or data from the central processing computer 303.

7. Para. [0254] of Joao reads as follows:

The apparatus 300 also comprises an account owner communication device 304 which may receive signals and/or data from either or both of the electronic cash device 302 and/or the central processing computer 303. In the preferred embodiment of Fig. 10, the communication device 304 receives signals and/or data from the central processing computer 303 with said signals being transmitted via a suitable a suitable communication system. In the preferred embodiment, the communications system utilized for transmitting signals and/or data to the communication device 304 is a wireless telephone line and the communication device 304 is a wireless telephone signal receiving device such as a telephone beeper or pager. The communication device 304, which may be a pager, receives the wireless telephone signals and/or data from the central processing computer 303 during the authorization procedure as will be described in more detail below.

8. Para. [0255] of Joao reads as follows:

In the preferred embodiment, the communication device 304 is also equipped with a transmitter for transmitting signals and/or data to the central processing computer 303. In this regard, the central processing computer 303 transmits signals and/or data to the communication device 304 as well as receives signals and/or data from the communication device 304. The communication device 304 may also transmit signals and/or data directly to the electronic cash device 302 and receive signals and/or data directly from the electronic case device 302. In the preferred embodiment, the electronic cash device 302 transmits signals and/or data to the central processing computer 303 and receives signals and/or data from the central processing computer 303. Further, in the preferred embodiment, the communication device 304 receives signals and/or data from the central processing computer 303 and transmits signals and/or data to the central processing computer 303.

9. Para. [0259] of Joao reads as follows:

The electronic cash device 302 also comprises a transmitter 302G for transmitting signals and/or data to the central processing computer 303, and/or to the communication device 304 and/or to any other device associated with the account owner and/or the apparatus, if desired. The transmitter 302G is also connected to the CPU 302A. The electronic cash device 302 also comprises a receiver 302H for receiving signals and/or data from the central processing computer 303, and from the communication device 304 and/or from any other associated device which may be utilized, if desired. The receiver 302H is also connected to the CPU 302A. The electronic cash device 302 also comprises a printer 302I or other appropriate output device for outputting data to the operator. The printer 302I is also connected to the CPU 302A. In the preferred embodiment, the printer 302I prints receipts corresponding to the electronic cash transaction.

10. Stewart is directed to a distributed network with wireless access points.

11. Laybourn is directed to a method of managing prepaid wireless service.
12. Bansal is directed to a method for transferring money using an electronic cash card. Bansal discloses wireless communication devices with cash-modifiable memory cards (see col. 3, ll. 47-49).
13. Jones is directed to an automated currency processing system.

Any differences between the claimed subject matter and the prior art

14. The claimed system differs from prior art in that it combines in a single system elements separately disclosed in the references. It also differs in that the prior art does not show a fee charged in response to the operation of a banking machine as result of the banking machine receiving a signal representative of a financial account and validating that the account is authorized to accept the fee (claim 2) or a fee associated with access to a network to “caus[e], with the automated banking machine, a fee to be associated with the account for providing the portable wireless device with access to the public wide area network”(claims 19 and 20).

The level of skill in the art

15. Neither the Examiner nor Appellants has addressed the level of ordinary skill in the pertinent art of financial transactions through wireless communication. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and

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a need for testimony is not shown'') (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Secondary considerations

16. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Definiteness

The test for compliance is whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the application disclosure as they would be interpreted by one of ordinary skill in the art. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

to a person having ordinary skill in the art to which said subject matter pertains.”” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18.

ANALYSIS

Rejection of claim 17 under 35 U.S.C. § 112, second paragraph, as being indefinite.

The Examiner argues: “[t]he recitation “relatively short” [in claim 17] is considered vague and indefinite. What is relatively short to one may not be relatively short to another.” Answer 4.

The Appellants respond by arguing that

Appellants' specification discloses at page 11, line 20 to page 12, line 1 that “alternative exemplary embodiments of the system 80 may use any other wireless network interfaces and systems between the portable wireless devices and the ATM, including for example generally short range RF communication such as Bluetooth™ and IR based systems.” One skilled in the art would recognize that the recited feature of “RF communication over

"relatively short distances" corresponds to the distances associated with short range RF communications carried out using Bluetooth™ RF communication systems for example. Once skill in the art would also recognize that the term "relatively" is with respect to other types of RF communication systems described in the specification which allow communication over longer distances such as IEEE 802.11b compatible wireless network interface described at page 11, lines 18-20.

With respect to the art of wireless access hubs, one skilled in the art would regard "RF communication over relatively short distance" as being definite and clear in view of the manner in which the Specification provides an enabling disclosure of this feature with respect to Bluetooth™ and IR based systems.

(Reply Br. 7).

We are not persuaded by Appellants' argument. As the Appellants have indicated, the Specification discloses "generally short range RF communication" (Specification 11:22 to 12:1). However, the Specification nowhere discloses that the phrase "relatively short distances" equates with "generally short range RF communication" or with systems, such as Bluetooth™ and IR based systems, that provide "short range" communication. The Appellants' assertions to the contrary are not supported by evidence. Thus, in using the ambiguous term "relatively" to describe the "short" distance over which RF communication is enabled by the wireless access hub, claim 17 does not set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the Specification as it would be interpreted by one of ordinary skill in the art.

Rejection of claims 1, 4, 6, and 18 under 35 U.S.C. § 102(e) as being anticipated by Joao.

We will not sustain this rejection.

Claims 1, 4, 6,

The Examiner found that

Joao et al discloses a method and apparatus comprising: receiving with an automated banking machine at least one first wireless communications signal from a portable wireless device which may be a voice communications device (para 0257; fig 10). There is disclosed sending and receiving first and second network communications to and from a server all through operation of the banking machine (para 0246). There is also disclosed sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device *corresponding* to the second network communication signal (para 0259).

(Answer 6). (Emphasis added.)

Notwithstanding the Examiner's finding, we are unable to find a teaching of "sending through operation of the banking machine at least one first network communication signal *corresponding* to the at least one first wireless communication signal, to at least one server ... [and] ... sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device *corresponding* to the at least one second network communication signal" (claim 1). While Joao discloses, at para. [0259] (see FF 9), an electronic cash device which can transmit and receive signals to/from both a communication device and a server, there is no teaching that the electronic cash device sends a signal to the server *corresponding* to a first wireless communication signal it receives, as claim 1 requires. Nor do we find any teaching of the electronic cash device sending a second signal to the communication device

corresponding to a signal received from the server, as claim 1 requires. While Joao encompasses various arrangements for transmitting and receiving signals to and from the electronic cash device, server, and communications device, sending signals *corresponding* to the receipt of another signal, as claim 1 requires, is not expressly or inherently described. Accordingly, we will not sustain the rejection under § 102 of claims 1, 4, and 6.

Claim 18

Claim 18 includes a step whereby the portable device is provided wide area network access (WAN) in response to the automated banking machine determining that the device is permitted access.

The Examiner found that “Joao et al discloses a network that is not proscribed to a limited geographical area.” (Answer 6). According to the Examiner, Joao “inherently discloses a wide area network or WAN.” (Answer 6).

The difficulty with the Examiner’s reasoning is that the method of claim 18 does not simply describe using a WAN. The method of claim 18 requires the automated banking machine to determine if the portable device is permitted access to a public WAN and, in response thereto, to provide the portable device with access to the public WAN through a wireless connection with the automated banking machine. The Examiner has not shown identity between what Joao describes and what is claimed. Accordingly, we will not sustain the rejection under § 102 of claim 18.

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Rejection of claims 1, 4, 6, and 18 as unpatentable over Joao.

The Examiner reasoning in making the determination of obviousness is the same as was presented in the anticipation rejection. See supra. In arguing for the reversal of this rejection, the Appellants rely on the arguments made in rebuttal to the § 102(e) rejection of these same claims over Joao. (See Reply Br. 5).

We will sustain this rejection.

Claims 1, 4, and 6

The issue is whether Joao discloses or suggests “sending through operation of the banking machine at least one first network communication signal *corresponding* to the at least one first wireless communication signal, to at least one server … [and] … sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device *corresponding* to the at least one second network communication signal” (claim 1).

The Appellant argues that Joao would not suggest the electronic cash device sending a signal to the server *corresponding* to a first wireless communication signal it receives and the electronic cash device sending a second signal to the communication device *corresponding* to a signal received from the server. (App. Br. 17).

We are not persuaded as to error in the rejection based on this argument. Joao discloses sending a signal from the electronic cash machine to the server and back again. (FF 6). The question is whether Joao would suggest to one of ordinary skill in the art sending a signal from the electronic cash machine to the server

which corresponds to a signal sent to the electronic cash machine from a communications device and sending a signal to the communications device which corresponds to the signal received by the electronic cash machine from the server. In the Joao system, the electronic cash machine and the server communicate with each other over financial transactions. (FF 6). The signals sent to/from the cash machine correspond to signals to/from the server. Joao further discloses sending information from a communication device to/from the electronic cash machine and to/from the server. (FF 8). Given that Joao indicates that objects of the invention are to allow an individual to obtain access to account transaction information on the server via the communications device (FF 2) and to provide a method for providing a wireless device owner, for example, to increase or decrease account credit limits. (FF 3). Joao would lead one of ordinary skill in the art to a system whereby one sends transaction information from the communication device to the electronic cash machine which in turn would send the information to the server. It would also lead to a system that would include the wireless device owner receiving updated financial account information from the server via the electronic cash machine. Such systems necessarily require the electronic cash device to send a signal to the server *corresponding* to a first wireless communication signal it receives and the electronic cash device sending a second signal to the communication device *corresponding* to a signal received from the server. Accordingly, we agree with the Examiner that the step of “sending through operation of the banking machine at least one first network communication signal *corresponding* to the at least one first wireless communication signal, to at least

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one server ... [and] ... sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device *corresponding* to the at least one second network communication signal" (claim 1) would have been obvious over Joao to one of ordinary skill in the art.

The Appellant also argued that Joao would not suggest to one of ordinary skill in the art placing the electronic cash device between the communication device and server. (Reply Br. 10). We disagree. Joao clearly discloses the wireless communication device communicating with the electronic cash machine and the electronic cash machine communicating with the server. (FF 8). This disclosure would lead one of ordinary skill in the art to the claimed arrangement whereby the electronic cash machine is placed between the wireless communication device and the server.

Claim 18

The method of claim 18 requires the automated banking machine to determine if the portable device is permitted access to a public WAN and, in response thereto, to provide the portable device with access to the public WAN through a wireless connection with the automated banking machine. Joao discloses that the electronic cash device and server may be connected to a wide area network, such as broadband. (FF 6). Since Joao also discloses the communications device communicating with the electronic cash machine, Joao suggests the communications device communicating with the electronic cash machine and thereafter, via the electronic cash machine, with a wide area network,

such as broadband. Given that it is a well-known feature of many WANs to restrict access to permitted users, a system to provide a portable device with access to the public WAN through a wireless connection with the automated banking machine that would first require the electronic cash machine to determine if the portable device is permitted access to a public WAN would have been obvious to one of ordinary skill in the art over Joao.

Regarding the limitation in claim 18 that the automated banking machine send the first communication signal corresponding to the signal received from the communication device to a server “in operative connection with the banking machine through a wide area network,” Joao discloses that the network through which the automated cash machine and server send/receive signals can be a WAN (FF 6). This suggests that the Joao server is “in operative connection with the banking machine through a wide area network.”

Rejection of claims 7, 11, 16, and 17 as unpatentable over Joao and Stewart.

Claim 7

Claim 7 is directed to an apparatus comprising “a wireless hub in operative connection with the computer [of an automated banking machine], wherein the wireless hub enables the [automated banking] machine to communicate with at least one portable wireless device, wherein the machine is operative to enable the at least one portable wireless device to communicate in [a] wide area network.”

The Examiner conceded that “Joao et al does not explicitly disclose a ‘wireless access hub’.” (Answer 6). The Examiner relied on Stewart (Fig. 1) as

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showing a wireless access hub. (Answer 6). The Examiner determined that “[i]t would have been obvious to one with ordinary skill in the art to include a wireless access hub as in the claimed relationship because Stewart et al teaches hub access useful in a business environment (col. 1, ll. 26-43).”

There is no dispute that Stewart discloses a wireless network infrastructure with access points. Wireless access “hubs” as access points in a wireless network infrastructure are well known to those skilled in the field of wireless network infrastructures.

The Appellants argue that the references do not disclose or suggest a wireless access hub in operative connection with an automated banking machine and enabling the machine to communicate with the at least one portable device. (App. Br. 29). (See also Reply Br. 12-13).

We are not persuaded by this argument.

Wireless access hubs are well known devices for enabling an efficient wireless communication between wireless devices. There is no dispute that Joao discloses a system whereby communication between the automated banking machine and the portable device can be handled wirelessly. The incorporation of well known wireless access hubs in the Joao system would, predictably, enable an efficient wireless communication between Joao’s automated banking machine and the portable device.

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739 and discussed circumstances in which a patent might be determined to be obvious

without an explicit application of the teaching, suggestion, motivation test. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* Here we see nothing unpredictable in incorporating well known wireless access hubs in the Joao system. The predictable result would be an efficient wireless communication between Joao’s automated banking machine and the portable device.

Claims 11, 16, and 17

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The Appeal Brief (i.e., pp. 30-31) indicates, without further discussion, that various features set forth in these claims are absent from the references. A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii) (2007). Accordingly, the decision of the Examiner to reject claims 11, 16, and 17 is affirmed

Rejection of claims 5 and 13-15 as unpatentable over Joao and Bansal.

Claim 5

Claim 5 further limits the portable wireless device of claims 1 and 4 to include “at least one memory including data representative of cash value, and further comprising modifying the data representative of cash value responsive to operation of the banking machine.”

The Examiner argued that Joao discloses a voice communication device but not with a memory with modifiable cash value data. The Examiner relied on Bansal to show “a portable wireless device that includes memory with modifiable cash value data (col. 3, lines 45-57).” (Answer 7). The Examiner determined that “[i]t would have been obvious to one with ordinary skill in the art to include disclose [sic] that the portable wireless device includes memory with modifiable cash value data because Bansal et al teaches cash transaction are made by use of wireless devices is desired (col. 1, lines 21-41).” (Answer 7).

The Appellants argued that “nowhere does Bansal disclose or suggest that its described phones ever communicate wirelessly with an automated banking machine. Further, nowhere does Bansal disclose or suggest modifying data representative of cash value in a memory of a phone responsive to operation of an automated banking machine.” (App. Br. 32-33). (See also Reply Br. 13-14).

We do not find Appellants’ arguments persuasive. The Examiner clearly relied on the disclosure of Joao, not Bansal, to show as known wireless communication between the communication device and the automated banking machine. Bansal shows, and this is not disputed, wireless communication devices with cash-modifiable memory cards. (FF 12). The claimed invention amounts to a simple substitution of the wireless communication device in Joao for the Bansal wireless communication device having a cash-modifiable memory card. The result obtained – a financial transaction system comprising a wireless communication device having a cash-modifiable memory card – is predictable and thus would have been obvious to one of ordinary skill in the art.

The rejection of claim 5 is sustained.

Claims 13

The Appellants make two arguments. (See App. Br. 33-34).

First, the Appellants argue that neither Joao nor Bansal show wireless access hubs. This feature is claimed in claim 7 on which claim 13 depends. That feature was said to be shown in Stewart. Given that claim 13 includes all the elements of claim 7, we presume the Examiner intended to include Stewart in the statement of

the rejection. In that regard, we incorporate herein our analysis of the question of obviousness of incorporating wireless access hubs in the Joao system with respect to the subject matter of claim 7. See *supra*. For the same reasons, we find nothing unpredictable in incorporating well known wireless access hubs in the Joao system and thus find the combination of the Joao system and wireless hubs to be obvious to one of ordinary skill in the art.

The second argument is that the references do not show “an automated banking machine that is operative to enable a portable wireless device including a data store with monetary value data, to communicate in the wide area network.” (App. Br. 34). This argument is not persuasive. The claimed subject matter amounts to a combination of known devices yielding no unpredictable result. Bansal shows, and this is not disputed, wireless communication devices with cash-modifiable memory cards. (FF 12). Cash-modifiable memory cards are data stores. Joao suggests an automated banking machine that is operative to enable a portable wireless device to communicate in the wide area network. See *supra* our analysis of the rejection of claim 7. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 127 S.Ct. at 1739.

Claims 14 and 15

Claim 14 depends on claim 13 and claim 15 depends on claim 14.

In addition to the argument raised against the rejection of claims 7 and 13, the Appellants argued that the references do not disclose or suggest “a computer of

an automated banking machine which is operative to cause modification of data representative of monetary value included in a data store of a portable device.” (App. Br. 34-35). We disagree. The question is whether the combination of the teachings of the references would suggest a computer that is *operative* to cause modification of data representative of monetary value included in a data store of a portable device. Given that we have found that Bansal shows wireless communication devices with cash-modifiable memory cards and that Joao discloses communication between a wireless communication device and a computer (electronic cash machine and/or server), the Joao computer is necessarily *operative* to cause modification of data representative of monetary value included in a data store of a portable device when the Joao system is combined with the Bansal communication device.

Accordingly, we will sustain the rejection as to claims 14 and 15.

Rejection of claims 2 and 19-20 as unpatentable over Joao and Laybourn.

Claim 2 further limits the method of claim 1 by adding steps of (a) the banking machine receiving a third wireless communication signal representative of a financial account, (b) the banking machine validating that the account is authorized to accept a usage fee charge, and (c) charging the usage fee in response to operation of the banking machine.

We do not see that the Examiner has addressed the limitations of claim 2. The Examiner argues that “Joao et al. nor Stewart et al disclose a usage fee or a fee charged responsive to device enabled to communicate with network. [But]

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Laybourn et al discloses a fee charged responsive to device enabled to communicate with network (col 1, lines 18-25).” (Answer 7). Laybourn (col. 1, ll. 18-25) does disclose a subscriber fee billed to those accessing a wireless service with a wireless device. On that basis, the Examiner determined that “[i]t would have been obvious to one with ordinary skill in the art to include a fee charged responsive to device enabled to communicate with network because Laybourn et al teaches such as conventional in the wireless art (col. 1, lines 20-21).” (Answer 8). However, the claimed method does not involve fees for using a wireless system but rather a fee charged in response to the operation of a banking machine as result of the banking machine receiving a signal representative of a financial account and validating that the account is authorized to accept the fee.

We reverse the rejection as to claim 2.

Claims 19 and 20

We likewise reverse the rejection of claims 19 and 20.

Unlike claim 2, where the fee is charged in response to the operation of a banking machine, claims 19 and 20 call for a fee associated with access to a network: “causing, with the automated banking machine, a fee to be associated with the account for providing the portable wireless device with access to the public wide area network.” (claim 19). Laybourn (col. 1, ll. 18-25) discloses a subscriber fee billed to those accessing a wireless service with a wireless device.

The Appellant argued that the art fails to provide a “teaching, suggestion or motivation to modify an automated banking machine … to cause a fee to be

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associated with the account for providing the portable wireless device with access to the public wide area network.” (App. Br. 41). We agree. Laybourn’s disclosure of charging a fee for wireless access to a network does not lead one to modify the Joao system to cause, with the automated banking machine, a fee to be associated with the account for providing the portable wireless device with access to the public wide area network.

Rejection of claims 9-10 as unpatentable over Joao, Stewart, and Laybourn.

Claims 9 and 10 further limit the apparatus of claim 7 such that the computer of the banking machine is operative to charge a fee.

The Examiner argued that “Stewart et al discloses … fees (col. 12, lines 2-10). It would have been obvious to one with ordinary skill in the art to include fees as claimed in claim 9, because Stewart discloses network access providers (col. 12, lines 2-10).” (Answer 6). The Examiner has also indicated that “Laybourn et al discloses a fee charged responsive to device enabled to communicate with network (col 1, lines 18-25). It would have been obvious to one with ordinary skill in the art to include a fee charged responsive to device enabled to communicate with network because Laybourn et al teaches such as conventional in the wireless art (col. 1, lines 20-21).” (Answer 7-8).

The Appellants argued that the prior art does not provide a teaching, suggestion or motivation to modify the banking machine to cause a fee to be

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charged responsive to a wireless device enabled to communicate with a network. (App. Br. 38-39 and Reply Br. 14).

The Appellants' argument is not commensurate in scope with what is claimed. Claim 9 does not require the apparatus to cause a fee to be charged, only that the computer is "operative" to cause a fee to be charged. In that regard, the Joao computer, which handles a variety of financial transactions, appears to be "operative" to cause a fee to be charged.

Rejection of claims 3, 8, and 12 as unpatentable over Joao and Jones.

Claims 3, 8, and 12 require the automated banking machine to dispense cash. Only claim 12 requires the dispensing of cash in response to the signal of at least one portable wireless device.

The Examiner argued that "Joao et al does not disclose a cash dispenser (responsive to input from the wireless device) from the automated banking machine. Jones et al discloses dispensing cash from the automated banking machine using a cash dispenser (col. 2, lines 42-46; Fig 1a). It would have been obvious to one with ordinary skill in the art to include a cash dispenser of Jones et al because Joao et al teaches dispensing cash per se (para 0189)." (Answer 8).

Claims 3 and 8

With respect to claims 3 and 8, the Appellants argued that the references do not disclose or suggest an automated banking machine that both receives a wireless signal from a communication device and dispenses cash. (App. Br. 43-44).

Joao shows an automated banking machine that receives a wireless signal from a communication device. The claimed subject matter modifies the Joao banking machine by adding a cash dispensing feature. Such a feature is shown in Jones. The combination yields, predictably, an automated banking machine which dispenses cash. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 127 S.Ct. at 1739. We would add that Joao further discloses that the electronic cash machine may be an integral component of a cashier. (FF 5). This would suggest to one of ordinary skill in the art an automated banking machine dispensing cash.

Claim 12

With respect to claim 12, the Appellants argued that the references do not disclose or suggest dispensing of cash in response to the signal of at least one portable wireless device. (App. Br. 45).

The Appellants’ argument is not commensurate in scope with what is claimed. Claim 12 calls for an apparatus whereby the computer in the banking machine “is *operative* to cause cash to be dispensed by the cash dispenser responsive to at least one input to the at least one portable wireless device.” Since the Joao electronic cash machine may be an integral component of a cashier and receives signals from the communications device for financial transactions, the Joao system would appear to include a computer that “is *operative* to cause cash to

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be dispensed by the cash dispenser responsive to at least one input to the at least one portable wireless device.”

CONCLUSIONS OF LAW

We conclude:

The rejection of claim 17 under 35 U.S.C. § 112, second paragraph, as being indefinite, is affirmed.

The rejection of claims 1, 4, 6, and 18 are rejected under 35 U.S.C. § 102(e) as being anticipated by Joao is reversed.

The rejection of claims 1, 4, 6, and 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Joao is affirmed.

The rejection of claims 7, 11, 16-17 under 35 U.S.C. § 103(a) as unpatentable over Joao and Stewart is affirmed.

The rejection of claims 5 and 13-15 under 35 U.S.C. § 103(a) as unpatentable over Joao and Bansal is affirmed.

The rejection of claims 2 and 19-20 under 35 U.S.C. § 103(a) as unpatentable over Joao and Laybourn is reversed.

The rejection of claims 9-10 under 35 U.S.C. § 103(a) as unpatentable over Joao, Stewart, and Laybourn is affirmed.

The rejection of claims 3, 8, and 12 under 35 U.S.C. § 103(a) as unpatentable over Joao and Jones is affirmed.

DECISION

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The decision of the Examiner finally rejecting claims 1-20 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

JRG

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